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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

7590 07/17/2002  
COOPER & DUNHAM LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to an optical recording medium, classified in class 369, subclass 272.
- II. Claims 4, 5, 19 and 20 drawn to an editing system and method for changing sequences, classified in class 369, subclass 30.07. ✓
- (divisive) III. Claims 6, 7, 8, 11, 12, 13, 21, 22, 25, 26 and 27 drawn to an editing system, classified in class 369, subclass 30.05. ✓
- (linking) IV. Claims 9, 10, 14, 15, 16, 17, 23, 24, 28, 29, 30, and 31, drawn to an optical audio file linking system/method, classified in class 369, subclass 30.09. ✓
- (erasing) V. Claims 18 and 32, drawn to an optical audio erasing system, classified in class 369, subclass 30.19. ✓

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II, III, IV and V are related as subcombinations disclosed as usable in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as erasing of data files. See MPEP § 806.05(d).
3. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as linking data files for data reproduction for interactive/user interaction. See MPEP § 806.05(d).
4. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as expanding data files for data expansion. See MPEP § 806.05(d).
5. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as breaking data files into its subcomponents. See MPEP § 806.05(d).

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6. The product limitations of Group I claims will be examined along with any of the above selected subcombinations.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter/separate field of classification and non/overlapping fields of search, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following distinct species of the claimed invention: Group III a & b (claims 11-13, 25-27 and 6-8,21 & 22 respectively) and Group IV a & b (claims 14-17,28-31 and claims 9,10,23 and 24 respectively).

Group III a & b are drawn to expanding a set of files into either a plurality of groups or a plurality of programs and groups. The examiner considers these distinct species to be OBVIOUS VARIANTS and hence will examine both species together if this group of claims is elected. If applicants can convince the examiner that these species are not obvious variants, then an election of species will be further required in responding to this Office action if this group of claims is elected.

Group IV a & b are drawn an editing ability for linking groups of files together. The examiner considers these distinct species to be obvious variants and hence will examine both species together if this group of claims is elected. If applicants can convince the examiner at the species are not obvious variants, then an election of species will be further required in responding to this office action if this group of claims is elected.

If applicants can convince the examiner that the above groups are distinct patentable (non-obvious variants) species then applicants are further advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Furthermore, if applicants fail to convince the examiner of the patentability distinction between the above species, e.g. agrees with the examiner's position that they are obvious variants, then if the examiner finds one of the inventions (of either Group III or Group IV) as unpatentable over the prior art, the evidence (or admission) may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Due to the complexity of the above restriction/election requirement, no telephone call was made to applicants represented to request an oral election to the above restriction requirement.

10. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


11. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653



AMP  
July 16, 2002